

## **REMARKS**

Claim 7 is rewritten as an independent claim to include the limitations of claim 1. Claim 7 was dependent from claims 1, 2, 3 and 4. New claims 8-10 correspond to the limitations of claims 2, 3 and 4, respectively. The amendments to claim 7 and the new claims 8-10 are supported in the specification and do not add new matter.

Claim 11 is a new claim which recites the embodiment of a double-sided adhesive sheet strip comprising a pressure sensitive adhesive. This new claim is supported throughout the specification and does not add new matter.

At page 2 of the office action, the appeal brief filed by the applicants and new grounds for rejection set forth in the instant Office Action are addressed. The applicants have elected to file this reply under 37 C.F.R. § 1.111 and shall not, at this time, reinstitute the appeal.

At pages 3-4 of the Office Action, the Examiner rejects claims 1-7 under 35 U.S.C. § 102(b) as being anticipated by Horiki *et al.* ("Horiki"). Reconsideration and withdrawal of this rejection is respectfully requested.

The Examiner does not provide the preamble of claim 1 with patentable weight and interprets the claim as a pressure sensitive adhesive comprising a mixture of at least one block copolymer, at least one tackifier and at least one water soluble polymer. The Examiner views Horiki as teaching a masking member comprising a base and an adhesive layer provided to protect an article from a surface treatment and asserts that Horiki comprises a water-soluble

polymer, adhesive such as a styrene-butadiene block copolymer and a stickifier such as a rosin copolymer. The Examiner further views Horiki as teaching elements of the dependent claims and with regard to claim 7 alleges that Horiki reads on a single sided adhesive strip. On this basis, the Examiner concludes that Horiki anticipates the present invention.

The preamble of the claims in the instant application should be given patentable weight. A preamble limits the invention set forth in a claim if the preamble recites essential structure or steps, or if it is 'necessary to give life, meaning, and vitality' to the claim. *Eaton Corp. v. Rockwell Intern. Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003); *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1784 (Fed. Cir. 2002). The preamble has the import of what the claim as a whole suggests for it. In other words, when the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects. *Eaton Corp, supra; Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995).

The specification for the instant application describes the invention as relating to a pressure sensitive adhesive for single or double sided sheet strips. (See, specification at page 1, lines 6-9 (¶ 0001).) Further, the object of the present invention, as set forth in the specification is "...to present a pressure sensitive adhesive for a single- or double-sided adhesive sheet strip which can

be redetached without residue or destruction even from sensitive substrates by extensive stretching essentially parallel to the plane of the bond and which possesses good bond strengths even on hydrophilic substrates such as glass or ceramic and even at elevated atmospheric humidity" (See, specification at page 3, lines 6-10 (¶ 0011).) Moreover, the surprising result of the present invention is that the water-soluble polymer brings about a distinct increase in holding power under moisture conditions on hydrophilic substrates (see, specification at page 4, lines 24-26 (¶ 0018)) which property is directly related to a particular utility of adhesive sheet strips, such as with the use of the redetachable sheet strips on ceramics found in baths and kitchens. Thus, based on the statements regarding the invention as set forth in the specification, the preamble describing the invention as a pressure sensitive adhesive for single-sided or double-sided adhesive sheet strips which are redetachable from a substrate without residue or destruction by stretching in the plane of the bond is necessary to give life, meaning, and vitality to the claim, and effectively defines the present invention encompassed within the claims. Hence, the preamble should be afforded the weight of a claim limitation.

Horiki discloses masking members consisting essentially of a molded foamed closed cell polystyrene base. The invention is described in Horiki as a new masking member consisting essentially of a molded foamed closed cell polystyrene base and an adhesive layer formed on a surface of the base by coating with a composition consisting essentially of an emulsion type adhesive in

which a water-soluble polymer is mixed. Thus, Horiki does not expressly or inherently disclose the present invention which is a pressure sensitive adhesive for single-sided or double-sided adhesive sheet strips redetachable from a substrate without residue or destruction by stretching in the plane of the bond that comprises a mixture of at least one block copolymer, at least one tackifier, and at least one water-soluble polymer. Therefore, the present invention is not anticipated by Horiki.

Moreover, claim 7 is rewritten in independent form to recite either a single-sided or double-sided sheet strip comprising a pressure sensitive adhesive that is redetachable from a substrate without residue or destruction by stretching in the plane of the bond, and claim 11 specifically claims a double-sided sheet strip. Clearly, Horiki does not expressly or inherently disclose the sheet strips of claims 7-11 in that Horiki merely discusses a masking tape which provides an alternative to the known methods of preventing the adhesive from a masking member from being left on a substrate when the masking member is removed. Such masking members are typically removed from substrates by pulling them off, not by stretching. Moreover, Horiki's water soluble polymer is added to an adhesive which is not taught as being stretchable; and is not taught as being residue less. In fact, the addition of the water-soluble polymer is taught to "...prevent the adhesive layer ...from transferring to the surface of the article..." (Col. 1, lines 45-48). Thus, Horiki provides no disclosure of either single or double-sided sheet strips comprising a water-soluble polymer containing

pressure sensitive adhesive redetachable from a surface by stretching. Thus, Horiki does not anticipate the present invention, including the embodiments of claims 7-11, as amended.

Further, the present invention is not obvious over Horiki. Horiki provides the art with disclosure and teaching involving masking tapes. The present invention, however, is different in that it pertains to a pressure sensitive adhesive comprising a mixture of at least one block copolymer, at least one tackifier, and at least one water-soluble polymer for single-sided or double-sided adhesive sheet strips which is redetachable from a substrate without residue or destruction by stretching in the plane of the bond. Based on the scope of Horiki as discussed above, there are clearly differences between the pressure sensitive adhesives and the sheet strips comprising those adhesives set forth in the amended claims such that one skilled in the art would not look to Horiki in developing the adhesives and sheet strips of the present invention which contain the water soluble polymer that provides a surprising increase in holding power under moisture conditions. Thus, comparing the scope of the art with respect to the disclosure of Horiki and the features of the present invention as set forth in the claims, the present invention is not obvious over Horiki.

At pages 4-6 the Examiner rejects claims 1-7 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,897,949 Lühmann ("Lühmann") in view of Horiki. Reconsideration and withdrawal of this rejection is respectfully requested.

In essence, the Examiner asserts that Lühmann discloses elements of the claims except for the water-soluble polymer, the amount and types of water-soluble polymer set forth in the claims and additives, including fillers. The Examiner, however, asserts that Horiki teaches the addition of release agents and water-soluble polymers which is said by the Examiner to improve weatherability and stickiness. The Examiner concludes that the present invention is obvious over Lühmann in view of Horiki. Further, at pages 6-9 of the Office Action the Examiner responds to the prior arguments of the applicants.

Horiki is directed to providing an alternative to the known methods of preventing the adhesive from a masking tape from being left on a substrate when the masking tape is removed. Such masking tapes are typically removed from substrates by pulling them off, not by stretching. Nothing in Horiki addresses anything at all about an adhesive that is redetachable by stretching. The prior art methods discussed by Horiki for preventing adhesive from a masking member from being transferred from the masking member to the substrate include the addition of a release agent in the adhesive composition. (See, U.S. Patent No. 4,868,045 at col. 1, line 31.) However, the release agent brings about a deterioration of stickiness, weatherability, heat resistance and the like. (See, U.S. Patent No. 4,868,045 at col. 1, lines 39-42.) Horiki solves this problem by eliminating the release agent and substituting a water-soluble polymer ("composition consisting essentially of ..."). As acknowledged by the Examiner, Lühmann does not concern the use of water-soluble polymers in adhesives.

Based on the foregoing, the scope of the prior art at the time of the invention from Lühmann and Horiki concerned water-soluble polymer applied in an adhesive for masking tapes which were said to provide weatherability and heat resistance, such masking tapes known to be removed by stretching. As evidenced by Lühmann, however, the use of water soluble polymers did not extend to adhesives redetachable by pulling in the plane of the bond. One skilled in the art would appreciate the substantial differences between masking tape materials such as those of Horiki and the materials of Lühmann. Based on these substantial differences, it would not have been obvious to modify the materials of Lühmann to include the water soluble polymers of Horiki in a pressure sensitive adhesive redetachable from a substrate without residue or destruction by stretching in the plane of the bond. This becomes particularly apparent considering 1) that Horiki teaches the use of the water soluble polymer for an increase in cohesive force whereas in the present invention the water soluble polymer is added to a redetachable strip which is already cohesive and 2) the inclusion of a water-soluble polymer for releasing properties would be counter-intuitive for a redetachable strip. Thus, Horiki would not lead one skilled in the art, among a myriad of design choices, to apply its water-soluble polymer to an adhesive such as that of Lühmann that is redetachable from a substrate without residue or destruction by stretching in the plane of the bond. Therefore, the present invention is not obvious over Lühmann in view of Horiki.

Moreover, Horiki needs the polymer for improving the cohesion, however, the present invention involves the use of the water soluble polymer for an increase in holding power, particularly in humid rooms. One skilled in the art would expect that water soluble polymers used in such conditions would lead to a reduction in adhesion. Thus, with the present invention considering the scope of the endeavor at the time of the invention to obtain an adhesive with increased performance in humid rooms, one skilled in the art would be taught away from applying the water soluble polymers of Horiki in the adhesives of Lühmann among the myriad of design choices in the art. Surprisingly, the adhesives of the present invention did not achieve a remarkable reduction of adhesion but in humid rooms unexpectedly resulted in remarkable improvement in adhesion. Thus, Horiki provided no impetus for the inventors to combine its water soluble polymer in an adhesive formulation redetachable from a substrate without residue or destruction by stretching in the plane of the bond. Hence, the present invention is not obvious over Lühmann in view of Horiki.

Moreover, the surprising and unexpected property, discussed above, that the adhesives of the invention provide an increase in holding power under moisture conditions on hydrophilic substrates overcomes the Examiner's *prima facie* assertion of obviousness. The benefit of this surprising property is apparent when one considers the need for such materials to secure items in a bathroom or kitchen with the desire to someday remove the item and redetach the adhesive without destruction or marking of the wall or fixture, such as a ceramic tile.

Accordingly, considering the unexpected properties, the present invention is not obvious over Lühmann in view of Horiki

Further, Lühmann concerns adhesive tapes which can be redetached without residue by pulling in the direction of the bond. Horiki on the other hand concerns a masking tape which is different from the types of adhesives of Lühmann. Only with the teaching of the present invention that water soluble polymers can be applied in an adhesive that can be redetached without residue by pulling in the direction of the bond can one apply the teaching of Horiki to modify Lühmann. Thus, the Examiner's analysis applies impermissible hindsight and, hence, the present invention is not obvious over Lühmann in view of Horiki.

Claim 7 is amended to recite a single-sided or double-sided adhesive sheet strip comprising a pressure sensitive adhesive which is redetachable from a substrate without residue or destruction by stretching in the plane of the bond, wherein the pressure sensitive adhesive comprises a mixture of at least one block copolymer, at least one tackifier, and at least one water-soluble polymer. Claim 11 recites the embodiment of the present invention pertaining only to the double-sided adhesive sheet strip. Certainly, one skilled in the art of making such a sheet strip would find no teaching, suggestion or motivation within either Lühmann or Horiki to combine these references considering that Lühmann concerns redetachable adhesives and Horiki concerns masking tape. Further, one skilled in the art looking at the state of the art discussed above would not consider the materials of Horiki as presenting a possible modification of materials

in the art of redetachable adhesive sheet strips such as those of the present invention, or of Lühmann for that matter. Hence, claims 7 and 11, as well as all of the claims of the instant application, are not obvious over Lühmann in view of Horiki.

The applicants do not waive any of the arguments presented in either the appeal brief or other papers filed in the instant application and reserve their right to reassert these arguments in any future submissions as may be necessary. Further, the applicants believe that the remarks set forth herein address the Examiner's response to the appeal brief set forth at pages 6-9 of the Office Action or that based on the remarks set forth above further discussion of the Examiner's response is not necessary at this time. The applicants reserve the right to further comment on the Examiner's response at pages 6-9 of the Office Action as may be necessary based on future papers in this prosecution.

In view of the present remarks it is believed that claims 1-11 are now in condition for allowance. Reconsideration of these claims by the Examiner is respectfully requested and the allowance thereof is courteously solicited. If the Examiner believes that further amendment of the claims is necessary, the Examiner is invited to contact the undersigned by telephone at 908-722-0700.

CONDITIONAL PETITION FOR EXTENSION OF TIME

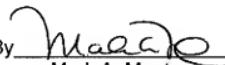
If any extension of time for this response is required, Appellants request that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fee or credit any excess to Deposit  
Account No. 14-1263.

Respectfully submitted,

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